REMARKS

This amendment responds to the office action mailed October 6, 2005. Claims 1 – 20 are pending.

In the office action the Examiner:

- assigned effective filing dates of: 11/5/1990 for claims 1 and 2, 7/9/1992 for claims 3 and 7, 6/21/1993 for claims 4, 19, and 20; and 7/30/03 for claims 5, 6, and 8-18;
- rejected claims 5, 6, 8-13, and 16 under 35 U.S.C. 102(b) as anticipated by Lee et al U.S. 5,911,835;
- rejected claims 5 and 6 under 35 U.S.C. 102(b) as anticipated by or alternatively obvious under 35 U.S.C. 103(a) over Ward U.S. 5,419,779, Lee U.S. 6,000,411, or Lee U.S. 5,672,577;
- rejected claims 8-13 and 16 under 35 U.S.C. 102(b) as being anticipated by Ward U.S. 5,419,779, Lee U.S. 6,000,411, or Lee U.S. 5,672,577;
- rejected claims 14, 15, 17, and 18 under 35 U.S.C. 103(a) over Lee U.S. 5,911,835, Lee U.S. 6,000,411, or Lee U.S. 5,672,577;
- rejected claims 1-20 as unpatentable under the doctrine of obviousness-type double patenting over the claims of U.S. Patent Nos. 6,825,156, 6,564,812, 6,399,551, 6,367,486, 6,276,372, 6,000,411, 5,911,835, and 5,482,566;
- rejected claims 1-3, 5-8, 11-15, 19, and 20 as unpatentable under the doctrine of obviousness-type double patenting over the claims of U.S. Patent Nos. 6,242,400 and 5,381,807; and
- provisionally rejected claims 1-20 as unpatentable under the doctrine of obviousness-type double patenting over the claims of U.S. Patent Application No. 10/442,858.

Regarding the effective filing dates, claim 3 clearly had support back to 11/5/1990. The background specifically includes plasma etching, reactive ion etching or ion milling as "such etching processes" and was part of the problem that was overcome by the invention disclosed in U.S. Patent No. 5,279,771. Nevertheless, since claim 3 is not subject to prior art rejections, the effective filing date is moot to this response.

Applicant also disagrees with the Examiner's effective filing date assessment for claims 4 and 7, in addition to the others described below. However, these claims are not subject to prior art rejection and therefore the effective filing date is moot to this response.

The Examiner states, most likely by error, that claims 5 and 6 have an effective date of 7/30/03 "due to the presence of 'about 2.5% to about 45% by weight neat hydroxylamine." Opinion, p. 2. However, claims 5 and 6 do not contain this language. Accordingly, claim 5, which depends from claim 1, clearly has support to 11/5/1990, particularly in view of one of skill in the art understanding that in preparing a bath, the constituents may be mixed at the time of preparation. See, '771 patent, col. 5, lines 11 – 14. ,This same reasoning applies to claim 6, which would distinctly have an effective date of 7/9/1992 due to the chelating agent. Claim 6 has been amended to delete the unnecessary wording limiting the addition of the chelating agent to "after" the addition of the other components. The optimum order of addition, if any, could be determined by routine experimentation based on the particular process.

Regarding the effective date of claims 8 – 18, the Examiner's reasoning for these having an effective date of 7/30/03 was "due to the presence of 'about 2.5% to about 45% by weight neat hydroxylamine." Opinion, p. 2. This has been amended to 2.5% neat to about 25% neat by amending claims 8 and 12, which is supported throughout the parent chain of applications. Accordingly, claims 8 – 18 now are accorded an earlier effective filing date of at most 6/21/1993.

Claims 19 and 20 are also not subject to any prior art rejections, accordingly the effective filing date is moot to this response.

Rejection Regarding US 5,911,835

Regarding the rejection to claims 5, 6, 8-13, and 16 under 35 U.S.C. 102(b) as anticipated by Lee et al (US 5,911,835).

First, claims 5 and 6 clearly have an effective date prior to March 27, 1997 for the reasons stated above. Accordingly, the '835 patent is not prior art to claims 5 and 6. Moreover, the Examiner misinterpreted the meaning of the abstract in making his rejection. The prior art fails to show that the combination of a nucleophilic amine compound, at least one organic solvent, water, and a chelating agent "has only short term stability" as alleged by the Examiner. In fact, the '835 patent teaches away from this proposition by stating that "[t]he presence of the chelating agent further provides the composition with long term activity and, therefore, a long shelf life." See, col. 4, lines 49 – 51. Further, "the chelating agent serves as a stabilizing agent to provide long term effectiveness to the composition." See, col. 4, lines 42-44. Accordingly, claim 6 is not anticipated by the disclosure of the '835 patent even if the effective date of claim 6 were later than March 27, 1997.

Similarly, claim 8 has been amended to have an effective date which obviates the '835 patent as prior art because claim 1 has been given an effective filing date of 11/5/1990 and the range of about 2.5% to about 25% by weight neat of hydroxylamine is supported in the continuity of parent applications extending prior to the '835 patent.

Claim 9 adds "a chelating agent" to claim 8, such as does claim 4, and accordingly is supported in the continuity of parent applications extending prior to the '835 patent and the '835 patent cannot be prior art to claim 9.

Claim 10 adds "at least one polar solvent" to claim 9. This is also fully supported in the continuity of parent applications (see, e.g., '835 patent, col. 7, lines 6-7; '881 patent, col. 7, lines 13-14) extending prior to the '835 patent, therefore '835 patent cannot be prior art to claim 10.

Claim 11 adds "the group consisting of monomers, diamers and triamers" which is supported through the continuity of parent applications (see, e.g., '835 patent, col. 8, lines 54-57; '881 patent, col. 8, lines 53-57) extending prior to the '835 patent, therefore the '835 patent cannot be prior art to claim 11.

Claim 12 adds that the method of removing a resist occurs after etching. This option is supported through the continuity of parent applications (see, e.g., '835 patent, col. 6, lines 55-67; '881 patent, col. 6, lines 62-67) extending prior to the '835 patent, therefore the '835 patent cannot be prior art to claim 12.

Claim 13 narrows the range of hydroxylamine to between 8.75 and 20% by weight. This is also supported through the continuity of parent applications (see, e.g., '835 patent, col. 10, Table I; '881 patent, col. 10, Table I) extending prior to the '835 patent, therefore the '835 patent cannot be prior art to claim 13. The other elements also extend back, as addressed above for each element.

Claims 14 and 15 specify that the composition contains at least 70% water. This is also fully supported through the continuity of parent applications and the '835 patent cannot be prior art to claims 14 and 15.

Claim 16, as 4, merely adds a chelating agent, as claims 4 and 9, with the same effect of rendering the '835 as not prior art.

Claims 17 and 18 merely expressly specifies one type of chelating agent that is disclosed from the '332 patent, to the '881 patent, to the '835 patent, and the '545 application. As stated by the Examiner, the "broad teachings" of these disclosures support "using a composition containing...an organic acid" as the chelating agent. Opinion, p. 7.

Claims 19 and 20 were also not subject to prior art rejection.

Rejections Regarding US 5,419,779, US 6,000,411, or US 5,672,577

Regarding the rejection to claims 5 and 6 under 103(a), as stated above, claims 5 and 6 do not contain the term "about 2.5% to about 45% by weight neat hydroxylamine" which resulted in the Examiner's assertion of a later effective filing date than the actual effective filing date. These claims, as argued above, merit an effective filing date well before the prior art cited above (e.g., the '779; the '411; and the '577) and is therefore unaffected by the '779, the '411, and '577 patents.

The Examiner's statement and treatment of these claims as a product by process instead of method claims appears incorrect. However, whether these are product by process are moot to this response because of the effective filing dates of claims 5 and 6 before the cited prior art.

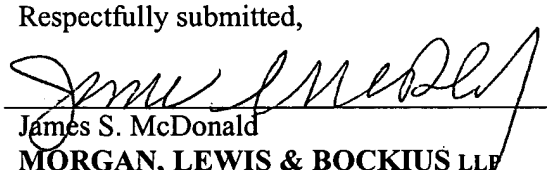
Similarly, as stated above, claims 8-18, as amended, now have an effective filing date that antedates the '779, '411, '835, and '577 patents. Accordingly, these are obviated as prior art.

In light of the above amendments and remarks, the Applicant respectfully requests that the Examiner reconsider this application with a view towards allowance. The Examiner is invited to call the undersigned attorney at (212) 309-6719, if a telephone call could help resolve any remaining items.

For the present response, other than the petition or terminal disclaimer included herewith, it is not believed that any fee is due. However, the Commissioner is authorized to charge any additional fee required or credit any overpayment for this response, the petition or terminal disclaimer, to Morgan, Lewis & Bockius LLP Deposit Account No. 50-0310, Order No. 60937-194-US. A second copy of this page is included herewith.

Respectfully submitted,

Date: April 6, 2006



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(Reg. No.)

James S. McDonald
MORGAN, LEWIS & BOCKIUS LLP
101 Park Avenue
New York, NY 10178
(212) 309-6000